

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

970054.479USPC

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

10/516,794

Filed

August 12, 2005

First Named Inventor

Aloys Wobben

Art Unit

2858

Examiner

Alexis Asiedua Boateng

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 47,435

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Timothy L. Boller/

Signature

Timothy L. Boller

Typed or printed name

(206) 622-4900

Telephone number

April 13, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Aloys Wobben
 Application No. : 10/516,794
 Filed : August 12, 2005
 For : METHOD AND APPARATUS FOR TRANSPORTING
 ELECTRICAL ENERGY

Examiner : Alexis Asiedua Boateng
 Art Unit : 2858
 Docket No. : 970054.479USPC
 Date : April 13, 2010

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW REMARKS

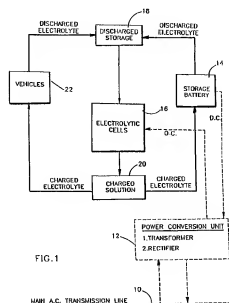
This request for pre-appeal review is in response to the Final Office Action mailed January 13, 2010.

The Examiner rejected claims 1-13, 15-18 and 21-25 under 35 U.S.C. 102(b) as anticipated by Goldman (WO 92/03869). It is noted that while the heading of paragraph 2 of the Final Office Action rejects claim 4, claim 4 was previously canceled. The Examiner rejected claims 14 and 19 under 35 U.S.C. 103(a) as obvious over Goldman (WO 92/03869) in view of Gupta (U.S. 5,349,535). The Examiner rejected claim 20 under 35 USC 103(a) as obvious over Goldman in view of Okada (U.S. 5,960,898). The Examiner's rejections are respectfully traversed.

The Examiner initially bears the burden of establishing a *prima facie* case of unpatentability. *In re Bell*, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984); MPEP § 2142. A rejection based

on alleged anticipation may be attacked by showing that a single element is missing from the cited reference. Under 35 U.S.C. § 102, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Here, the Examiner has failed to establish a *prima facie* case of anticipation. The Examiner erred in asserting that Goldman teaches or enables each of the claimed elements, either expressly or inherently, as interpreted by one of ordinary skill in the art.

Independent claim 1 recites, “the storage device is arranged as a payload for the vehicle and in the receiving and transmitting of the electrical energy the storage device remains arranged as a payload for the vehicle.” Independent claim 15 similarly recites, “[a] method of storing and transporting electrical energy by means of a vehicle carrying an electrical storage device as a payload.” The Examiner points to battery 14 and cells 16 of electrolytic reprocessing subsystem of Figure 1, as well as lines 6-16 of page 7, as allegedly teaching a storage device arranged as a payload for a vehicle. The battery 14 and cells 16 of reprocessing subsystem of Goldman are part of a recharging station, and thus are not arranged as a payload for a vehicle. For convenience, Figure 1 and lines 1-16 of page 7 of Goldman are reproduced below.



In the illustrated embodiment, discharged slurry is stored in a discharged slurry storage facility 18 and supplied to electrolytic cells 16 via suitable pumps (not shown). The charged slurry is received in a facility 20 and then stored in storage battery 14 or supplied to electric vehicles 22.

Discharged slurry is received at facility 18 from the electric vehicles 22 and from storage battery 14. The storage battery 14 provides, when necessary or economical, electrical power to transmission line 10 via conversion unit 12.

It will be appreciated by persons skilled in the art that the present invention, through the synergistic combination of two disparate activities, utility energy storage and electric vehicle operation, each of which is presently uneconomical, provides economical electrical utility off-peak power storage, surge protection, on-peak and super-peak demand power supply, spinning reserve and electric vehicle system.

As can be seen, neither the battery 14 nor the electrolytic cells 16 are loaded on the vehicle. Instead, discharged slurry is received at facility 18 from the electric vehicles 22 and from storage battery 14. Goldman says nothing about the battery 14 or the cells 16 of reprocessing subsystem being arranged as a payload for a vehicle. The batteries 14 and cells 16 of Goldman are never loaded on the vehicle, and thus are not arranged as the payload for the vehicle. To the extent the Examiner's reference to page 7, line 25 to page 8, line 18 might refer to unidentified batteries which power an electric vehicle (it is noted that batteries 44 and 50 discussed in the cited portion of Goldman appear to be part of the station, just like battery 14, and are not loaded on a vehicle), or slurry loaded into such batteries, because such batteries power the vehicle, neither such batteries nor such slurry are arranged as a payload for the vehicle. Accordingly, claims 1 and 15 are not anticipated by Goldman. Claims 2, 3, 5-14, 16-18 and 20-24 are not anticipated by Goldman at least by virtue of their dependencies, and in addition are allowable for the novel and non-obvious combinations recited therein.

In response, the Examiner points to battery 14 and Figure 3 of Goldman. The Examiner does not address the fact that the battery 14 is never loaded on the vehicle. Figure 3 shows discharged slurry being removed and charged slurry being supplied to the vehicles. There is no indication that the vehicles of Figure 3 include storage devices arranged as a payload. If discharged slurry is removed from any unidentified battery in the vehicle, such batteries are being used to power the vehicle and thus neither the batteries nor the slurry are arranged as a payload for the vehicle. To the extent the Examiner is making an inherency argument, any such contention is respectfully traversed and evidentiary support is respectfully requested.

Independent claim 25 recites, "[a] vehicle, comprising: means for storing electrical energy ... arranged as a payload for the vehicle." The Examiner points to Figure 4, item 74. Item 74 of Figure 4 is a tank that stores discharged fluid received from a vehicle. The tank is part of the reprocessing subsystem 16 and is not arranged as a payload for a vehicle. See Figure 4 of Goldman. Accordingly, claim 25 is not anticipated by Goldman.

The Examiner has failed to establish a *prima facie* case of anticipation, and thus claims 1-3, 5-13, 15-18 and 21-25 are allowable.

The Examiner rejected claims 14 and 19 under 35 USC Section 103(a) as obvious over Goldman in view of U.S. Patent No. 5,349,535 issued to Gupta. The Examiner rejected Claim 20 under 35 U.S.C. 103(a) as obvious over Goldman in view of Okada (U.S. 5,960,898). The Examiner's rejections are respectfully traversed.

An obviousness rejection may be attacked by showing that the Examiner has failed to properly establish a *prima facie* case or by presenting evidence tending to support a conclusion of non-obviousness. In order to find *prima facie* obviousness when combining references, MPEP § 2143(A)(1) states the following (emphasis ours): "Office personnel must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." MPEP § 706.02(j) further states (emphasis ours): "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

Claims 14 depends from claim 1, and the Examiner does not contend that Gupta supplies the teachings of claim 1 discussed above and missing from Goldman. Thus, the Examiner has not established a *prima facie* case of obviousness and claim 14 is allowable.

Claim 19 recites, "a vehicle carrying an electrical storage device as a payload." The Examiner does not contend that Gupta teaches, suggests or motivates a storage device arranged as a payload of a vehicle, which as discussed above with regard to claim 1 is not taught, suggested or motivated by Goldman. Thus, the combination of Goldman and Gupta does not render obvious the recited storage device. Accordingly, claims 14 and 19 are not rendered obvious by Goldman, alone or in combination with Gupta.

In addition, claim 19 recites, "monitoring a number of charge/discharge cycles for each storage element; and outputting a corresponding notification when a predetermined number of cycles is reached." The Examiner points to column 10:10-19 and column 11:66 to

(presumably) column 12:8 of Gupta. The cited portions generally discuss maintaining data and providing transaction and service notifications when a vehicle is coupled to a charging station. There is no discussion of outputting a notification when a predetermined number of cycles is reached. The Examiner did not respond to this argument.

The Examiner rejected Claim 20 under 35 U.S.C. 103(a) as obvious over Goldman in view of Okada (U.S. 5,960,898). Claim 20 depends from claim 1. The Examiner does not contend that Okada teaches, suggests or motivates a storage device arranged as a payload of a vehicle, which as discussed above with regard to claim 1 is not taught, suggested or motivated by Goldman. Accordingly, claim 20 is not rendered obvious by Goldman, alone or in combination with Okada.

For at least the forgoing reasons, independent claims 1, 15, 19 and 25 are allowable in view of Goldman and Gupta and Okada. In addition, the dependent claims are allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations recited therein. Thus, the rejection of claims 1-3 and 5-25 cannot be sustained.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC
/Timothy L. Boller/
Timothy L. Boller
Registration No. 47,435

TLB:jrb

701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
Phone: (206) 622-4900
Fax: (206) 682-6031

1599370_1.DOC